

REMARKS

In accordance with the foregoing, claims 10, 29, and 30 have been amended. Claim 31 has been added. Claims 1-31 are pending and under consideration.

Rejection of Claims 10-30 Under 35 U.S.C. §112:

On page 2 of the Office Action, claims 10-30 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed and reconsideration is requested.

The Office Action sets forth "there is no definition of mounting surface in the specification, and that such a recitation is indefinite" However, breadth is not the same as indefiniteness. The claimed mounting surface clearly refers to a surface mounting the disk. In addition, these rejected claims do not differentiate between the mounting surface and the "flange" as recited in alternate claim sets. This is where the Office Action would appear to be mistaken, i.e., a mounting surface can also be a flange. New dependent claim 31 sets forth the same.

As such, it is respectfully requested that this rejection of claim 10-30 be withdrawn and claims 10-30 be allowed.

In addition, it is briefly noted that, as a general principle, 35 U.S.C. §112, second paragraph, requires only that the claims be written such that, in light of the available prior art and the embodiments in the specification, one of ordinary skill in the art would understand the metes and bounds of the invention with a reasonable degree of precision.

It is only when, in light of the prior art and the specification and given their broadest reasonable meaning under normal rules of claim construction, a recited term remains unclear to one of ordinary skill in the art that the claim term is said to be indefinite for the purposes of 35 U.S.C. §112, second paragraph. MPEP 2173.02 (2003).

Again, mere breadth of a claim limitation, without supporting evidence that the breadth leads to confusion for one of ordinary skill in the art, is not sufficient to support an indefiniteness rejection. MPEP 2173.04. As such, when applicants describe an element in terms of its function, as noted in MPEP 2173.05(g), the functional description is deemed compliant with 35 U.S.C. §112, second paragraph, unless the Examiner is able to show that one of ordinary skill in the art would be unable to understand the metes and bounds of the claim. Thus, the mounting surface is not indefinite, when read in view of the specification and other claims.

Regarding the §112, first paragraph rejection, it is respectfully submitted that the Examiner has misunderstood the presently claimed invention. As noted above, the claimed "mounting surface" can be any surface for mounting the claimed disk. Applicants are not required to explain each and every potential embodiment. Rather, the described flange is at least one of the disclosed potential elements meeting this claimed term, noting that other features, disclosed or potential, may also correspond to the same.

In addition, it is respectfully submitted that the Office Action has failed to set forth a prima facie enablement rejection

"[The specification] need only be reasonable with respect to the art involved; they need not inform the layman nor disclose what the skilled already posses. They need not describe the conventional...The intricacies need not be detailed ad absurdum." General Electric Co. v. Brenner, 159 USPQ 335 (D.C. Cir. 1968). In addition, a defining aspect of enablement is that there isn't undue experimentation, i.e., experiment required to reproduce the claimed features is satisfactory, as long as it isn't undue experimentation. In re Geerdes, 180 USPQ 789, 793 (CCPA 1974).

In addition, as noted in MPEP § 2163.04, a "description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption." The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The Examiner has the initial burden or presenting by the a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention as defined by the claims.

MPEP § 2163.04(I) further details that in rejecting a claim; "the examiner must set forth express findings of fact which support the lack of written description." As further detailed, "[t]hese findings should: (a) Identify the claim limitation at issue; and (B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as filed. A general allegation of 'unpredictability in the art' is not a sufficient reason to support a rejection for lack of adequate written description."

Thus, it is respectfully submitted that the presently claimed invention is enabled by the present application. It is further respectfully submitted that this outstanding 112, first paragraph, rejection fails to meet the prima facie enablement standard, as required in the MPEP. Therefore, withdrawal of this enablement rejection is respectfully requested.

On page 4 of the Office Action, claims 1-30 were rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action sets forth “the preambles for all the independent claims recite a “magnetic head parking system”, but the bodies of these claims do not contain any head parking structures.”

By way of review, claim 1 of the present invention recites “a head limiter provided on an upper surface of the flange...” It is noted that the body of the claims clearly contains “a head limiter” which corresponds to a head parking structure.

Accordingly, it is respectfully submitted that the rejection of claims 1-30 be withdrawn and claim 1-30 be allowed.

Rejection of Claims 10-17, 20, 23, 29, and 30 Under 35 U.S.C. §102(b):

Claims 10-17, 20, 23, 29, and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Khanna et al. (U.S. Patent No. 5,640,290). This rejection is respectfully traversed and reconsideration is requested.

Claims 10, 29, and 30 have been amended to clarify the presently claimed invention.

The Office Action sets forth Khanna et al. shows a disk drive with a head limiter system that includes projections located in a parking zone that limits the vertical movement of the head and suspension due to shock loading. The limiters are located both directly opposite the slider and offset from slider.

However, by way of review, Khanna et al. only sets forth a limiter disposed directly opposite from a head, and fails to disclose a limiter disposed between a head and the secured end of an actuator.

Accordingly, it is respectfully requested that this rejection of claim 10 be withdrawn and claim 10 be allowed.

Further more, it is also respectfully submitted that this rejection of claims 11-17, 20, 23, 29, and 30 be withdrawn and claims 11-17, 20, 23, 29, 30 allowed, as well as for the additional recitations therein.

Rejection of Claims 1-3, 5-7, 21, and 22 under 35 U.S.C. §103:

On page 4 of the Office Action, the Examiner rejected claims 1-3, 5-7, 21, and 22 under 35 U.S.C. 103(a) as being unpatentable over Khanna et al. (U.S. Patent No. 5,640,290). This

rejection is respectfully traversed and reconsideration is requested.

First, it is noted that the Office Action's interpretation of mounting surface is incorrect. A base plate of a disk drive cannot "reasonably" be considered to mount the claimed disc.

Secondly, the Office Action sets forth that Khanna et al. does not disclose a) locating the limiter on the flange of the spindle motor, b) specifying the exact range of motion allowed, c) showing the shape of the limiter.

However, without additional supporting evidence, the Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the limiter on the flange on the spindle motor.

As a general matter, in order to establish a prima facie obviousness rejection, the Examiner needs to provide both the existence of individual elements corresponding to the recited limitations, and a motivation to combine the individual elements in order to create the recited invention. Both the individual elements and the motivation need to be shown to have existed in the prior art. Should the Examiner fail to provide "evidence" that either one of the individual elements or the motivation does not exist in the prior art, then the Examiner has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claim. MPEP 2143.03.

Thus, the burden is initially on the Examiner to provide "evidence" as to why one of ordinary skill in the art would have been motivated to combine the individual elements to create the recited invention, and to demonstrate that this evidence existed in the prior art.

As an example, MPEP 2143.03 refers to In re Koltzab, 55 USPQ2d 1313 (Fed. Cir. 2000). In In re Koltzab, the Federal Circuit agreed with the Patent Office and the Examiner that the prior art, as a whole, disclosed each of the individual elements of the recited invention, which was an injection molding machine. However, the Federal Circuit held that "a rejection [for obviousness] cannot be predicated on the mere identification in [one of the prior art references] of individual components of the claimed limitations." Instead, the Federal Circuit held that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." Id. at 1317. As such, in order to establish a prima facie obviousness rejection of a claim, the Examiner needs to both provide this **particular evidence** of the motivation to make the combination, and show that this evidence existed in the prior art. MPEP 2141.03.

As acknowledged by the Office Action, Khanna et al. fails to disclose "locating the limiter on the flange of the spindle motor," as recited in claim 1. Further more, Khanna et al. fails to

teach or show “specifying the exact range of motion allowed” as recited in claims 5 and 25. In addition, Khanna et al. fails to teach or show “the shape of limiter” as recited in claims 6 and 22. As such, it is respectfully submitted that Khanna et al. fails to teach or suggest how/why to combine “a head limiter provided on an upper surface of the flange of the spindle motor...” as recited in claim 1.

In addition, it is respectfully submitted that supporting “motivation” must be evidenced in the record. Conclusory, statements of obviousness or motivation for the same are insufficient. Motivation must be evidenced in the record.

Therefore, for at least the above, it is respectfully requested that this rejection of claims 2-3, 5-7, 21, and 22 be withdrawn and claims 2-3, 5-7, and 22 are also in proper condition for allowance.

Objections of Claims:

At page 5-6 of the Office Action, claims 4,8,9, 18, 19, and 24-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As discussed above, claim 4, 8, 9 and 18,19, and 24-28, which depend from claims 1 and 10, respectively, are also submitted to be allowable for the same reasons as claims 1 and 10, as well as for the additional recitations therein.

Conclusion:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date:

3/4/05

By:


Stephen T. Boughner
Registration No. 45,317

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501